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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,917	11/06/2003	Rong-Jung Lee	10948-US-PA	2916

31561 7590 07/22/2008

JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE  
7 FLOOR-1, NO. 100  
ROOSEVELT ROAD, SECTION 2  
TAIPEI, 100  
TAIWAN

EXAMINER
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REZA, MOHAMMAD W

ART UNIT	PAPER NUMBER
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2136

NOTIFICATION DATE	DELIVERY MODE
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07/22/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USA@JCIPGROUP.COM.TW  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/605,917	<b>Applicant(s)</b> LEE, RONG-JUNG	
	<b>Examiner</b> MOHAMMAD W. REZA	<b>Art Unit</b> 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is in response to the arguments filed on 04/17/2008.
2. Claims 1-14 are pending in the application.
3. Claims 1-14 have been rejected.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

### ***Response to Amendment***

4. The examiner does not approve the amendments made to claims 1, 13, and 14.

### ***Specification***

1. The amendment filed 04/17/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: it is clear that the specifications and figure has been amended by adding "is to be locked" by replacing

previously written "is locked" intentionally to provide the written support to the claims' amendment which distinctly raises the new matter issue regarding the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1-14 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The initial claim which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant added the new limitations "is to be locked" which is not supported by the initial specification. The initial drawings (dated 11/06/2003), initial specification (dated 11/06/2003) or any disclosure has support "is to be locked" which is significantly changing the meaning of the claim from its previous limitation "is locked".

3. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. All the independent claims has the limitations "providing at least one key that

provides a signal to allow the EC....". Examiner could not find any place in the specification that has the this written description support for this limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In these claims applicants mention "at least one key that provides a signal", which is generally narrative and indefinite with the invention. Applicants do not point out clearly which options include in the present invention by these two terms. The well known meaning of the "key" is to encrypt or encode any data. However, the intended meaning of key in these claims limitation is ambiguous as it does not do any kind of encoding or encryption. Rather, it is not clear that what the use of this "key". So, this limitation is indefinite with the present application. The examiner will interpret these terms and limitations with the regarding claims as best understood for applying the appropriate art for rejection purposes. Appropriate correction needs to overcome the rejection.

### ***Response to Arguments***

8. Applicant's arguments filed on 04/17/2008 have been fully considered but they are not persuasive.

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Applicant argues that the combined teachings of Hale and Lin do not disclose “providing a key that provides a key signal to allow the EC to learn whether the portable computer is to be locked”. According to any ordinary person skilled in the art the broadest interpretation of this limitation is to provide the key signal to allow the EC to learn whether the portable computer is to be locked. Although, applicant mentions “at least one key” but this key is not any encrypted key that the universal meaning carrying by the term “Key”. This is just a signal (initiation Signal) which will allow the EC to learn the status of the portable computer. So, examiner respectfully disagrees that this teaching is absent in the combined teachings of Hale and Lin. Hale discloses that the keyboard controller (EC) deactivate the display after the predetermined period of inactivity by sending signals to the host computer which indicate to the host computer to blank the display (col. 4, lines 56-63). He also mentions that the keyboard controller which is connected with the peripheral device of the computer thorough the signal line may blank (lock) the display by means issuing the blanking signal code to the that peripheral device (col. 13, lines 13-34). In addition, he also discloses the peripheral device controller (EC) if the peripheral device remains inactive for some certain period of time then that controller deactivate that particular device (col. 3, lines 27-35, col. 2, lines 11-29). All these cited portions from Hale’s invention disclose the claim limitation, providing the key signal to allow the EC to learn whether the portable computer is to be locked”. In the same way, Lin discloses comprises the key to deactivate the wireless computer (paragraph, 0005). He also mentions that the controls key is able to disable the remote controller’s wireless function (paragraph 0015). Additionally, he also teaches that the

security apparatus transmits the data which is used to control (shut down) the notebook computer (paragraph 0016). The aforementioned paragraphs clearly emphasize that the control key provides data to the security apparatus (EC) to lock the portable computer. So, there is no doubt that the combined teachings of Hale, and Lin disclose the gist of the claim limitations.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hale et al hereafter hale (US Patent 5355414) in view of Lin et al hereafter Lin (US Patent application 20030095044).

7. As per claim 1, Hale discloses a computer equipped with an embedded controller (EC), comprising steps of: providing a key that provides at least one key signal to allow the EC to learn whether the portable computer is to be locked (abstract, col. 1, lines 37-45, "keyboard controller" acting as a "embedded controller"); turning on the security mechanism while the EC receives the key signal indicating that the portable computer is locked (col. 2, lines 1-24); determining only by the EC whether a hacking action is taking place; and activating a security action in responding to the hacking action (col. 2, 36-50). Though Hale discloses security for personal computer he does not expressly

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disclose a portable computer. However, in the same field of endeavor, Lin discloses a portable computer to provide a key that provides a key signal to learn whether the portable computer is to be locked (paragraphs, 0005, 0015).

Accordingly, it would be obvious to one of ordinary skill in the network security art at the time of invention was made to have incorporated Lin's teachings of portable computer security with the teachings of Hale, for the purpose of suitably using the security mechanism to protect portable notebook from unauthorized use (paragraphs 0005).

8. As per claim 2, Hale discloses the computer wherein the security mechanism prevents the portable computer from being turned on (abstract, col. 1, lines 37-45). He does not disclose the portable computer. However, Lin discloses the portable computer (paragraphs, 0005, 0015).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 2.

9. As per claim 3, and 4, Hale discloses the computer wherein the security mechanism prevents an input from a keyboard, wherein the security mechanism prevents an input from a mouse (col. 2, lines 1-24).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 3, and 4.

10. As per claim 5, Hale discloses the computer wherein the security mechanism prevents a basic input/output system (BIOS) data from being changed (col. 3, lines 6-25).



11. As per claim 6-8 Hale discloses the computer wherein the key is an internal device or an internal function of the computer, wherein the key is an external device or an external function of the computer wherein the key signal is a binary signal (abstract, col. 1, lines 37-45). He does not disclose the portable computer. However, Lin discloses the portable computer (paragraphs, 0005, 0015).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 6-8.

12. As per claim 9-12 Hale discloses the computer wherein a related follow-up procedure of a security function takes place when a hacking action is detected by the security mechanism, wherein the related follow-up procedure turns off the computer, wherein the related follow-up procedure turns off a monitor device of the computer, wherein the related follow-up procedure executes a security program (col. 2, 36-50). He does not disclose the portable computer. However, Lin discloses the portable computer (paragraphs, 0005, 0015).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 9-12.

13. As per claim 13, and 14, Hale discloses an embedded controller (EC) and security mechanism equipped to a computer, comprising steps of: providing a key that provides EC key signal to allow the EC to learn whether the portable computer is to be locked (abstract, col. 1, lines 37-45, “keyboard controller” acting as a “embedded controller”); turning on the security mechanism while the EC receives the key signal indicating that the portable computer is locked (col. 2, lines 1-24); determining only

whether a hacking action is taking place and activating a security action in responding to the hacking action (col. 2, 36-50). Though Hale discloses security for personal computer he does not expressly disclose a portable computer. However, in the same field of endeavor, Lin discloses a portable computer to provide a key that provides a key signal to learn whether the portable computer is to be locked (paragraphs, 0005, 0015). The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 13-14.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad w. Reza whose telephone number is 571-272-6590. The examiner can normally be reached on M-F (9:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MOAZZAMI NASSER G can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Nasser G Moazzami/

Mohammad Wasim Reza

Supervisory Patent Examiner, Art Unit 2136

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